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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,172	04/21/2004	Ralf Schliephacke	101769-254 (tesa AG 1635)	8156
27384 7590 06/22/2009 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER SELLS, JAMES D				
ART UNIT		PAPER NUMBER		
1791				
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06/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/830,172

**Applicant(s)**

SCHLIEPHACKE ET AL.

**Examiner**

James Sells

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khatib (US Patent 5,370,420) in view of Treleven (US Patent 6,413,345).

Regarding claim 1, Khatib discloses a method of making pressure sensitive labels. As shown in the figure, the method involves providing a face sheet 24 on web 12. Face sheet 24 is provided with a pressure sensitive adhesive on its underside (see col. 2, lines 31-33). Face sheet 24 is die cut vertically and horizontally along lines 28, 30, 32 and 34 to form individual labels 26 (see col. 2, lines 38-45). These cross die cuts extend over the entire width of face sheet 24 in the manner claimed by the applicant. In addition, the specification only describes die cutting face sheet 24, not web 12 and the figure only shows the die cuts in face sheet 24, not in web 12. Therefore during the cross diecutting, the backing material (web 12) is not cut into or is only cut into insignificantly in the manner claimed by the applicant. Web 12 comprises a release coated liner that is coated on the upper surface with a conventional release coating (see col. 2, lines 25-28).

However, Khatib does not disclose the die cut line configuration as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Treleaven.

Treleaven discloses a method for making labels. This method employs die cut station 30 to for tear lines 135A, 135B, 155A, 155B and 158 in the labels. In particular, Figs. 2 shows the tear lines with a saw-toothed configuration.

It would have been obvious to one having ordinary skill in the art to employ a saw-toothed tear line, as taught by Treleaven, in the method of Khatib as a matter of choice based on desired physical properties (i.e. ease and effectiveness of use by the consumer) and functionality of the labels being produced. In addition, since both Khatib and Treleaven teach cut lines, it would have been obvious to one having ordinary skill in the art to substitute one type of cut line for another in order to achieve predictable results.

Regarding claim 2, the figure of Khatib shows diecuts 28, 30, 32 and 34 surrounding labels 26. The top and bottom portions of these diecuts are cut at an angle of substantially 90° in relation to the direction of the web in the manner claimed by the applicant.

Regarding claim 3, Figs. 2-3 and 8 of Treleaven shows dies cut tear lines with a sawtooth-like or zigzag-formed pattern. Motivation has been provided above (see the rejection of claim 1) to employ these die-cut tear lines of Treleaven in the method of Khatib.

Regarding claim 4, Khatib discloses the web of labels (face sheet 24) includes a pressure sensitive adhesive layer its underside (see col. 2, lines 31-33).

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khatib in view of Treleven as described above in paragraph 2 in further view of Bausewein et al (US Patent 5,482,779).

Regarding claim 5, Khatib does not disclose the anti-adhesive coating on both sides of the backing materials as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Bausewein

Bausewein discloses a process for manufacturing a label. As shown in Fig. 1, the label product 12 comprises printable recording medium or film 1, adhesive layer 2, intermediate layer 4, adhesive layer 4 and carrier sheet or foil 5. At col. 5, lines 30-36, Bausewein discloses that carrier foil 5 can preferably be coated on both sides with silicone in order to produce a primary laminated material which can serve as the base material for receiving a variety of printable materials thereon.

It would have been obvious to one having ordinary skill in the art to employ carrier or backing material with an anti-adhesive material coating on both sides thereof, as taught by Bausewein, in the method of Khatib in order to provide the predictable result of providing a carrier material which can serve as the base material for receiving a variety of printable materials thereon. In addition, since Bausewein discloses the same silicone material on both sides of the backing or carrier material, it is the examiner's

position that these silicone coatings inherently do not differ substantially in the degree to which they repel the same layer of adhesive in the manner claimed by the applicant.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khatib in view of Treleaven as described above in paragraph 2 in further view of Scholz et al (US 2002/0041945).

Regarding claim 6, Khatib does not disclose dispensing the diecuts at a rate of 0.3-2.0 m/s as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Scholz.

Scholz discloses feeding diecut materials at web speeds of about 0.75 m/s up to about 1.5 m/s. See paragraph [0056].

It would have been obvious to one having ordinary skill in the art to employ web speeds of about 0.75 m/s up to about 1.5 m/s, as taught by Scholz, in the method of Khatib, in order to provide the predictable result of producing articles at a fast rate of speed.

#### ***Response to Arguments***

5. Applicant's arguments filed 02/24/2009 have been fully considered but they are not persuasive.

Applicant argues the dispensing speed (greater than 0.3 to 2.0 m/s) constitutes unexpected results. Applicant further asserts that since such dispensing speeds are not recited in applicant's claims (claim 6), applicant's claims are now patentable over the

prior art. The examiner does not agree. Feeding/dispensing diecut materials at a rate in the range recited in applicant's claims is known in the prior art (see Scholz et al – paragraph [0056] as described above). Therefore applicant's argument is not persuasive in this instance.

Applicant requests a response to the *Merchant* decision. First, all of the method steps applicant alleges produce unexpected results are known to the prior art (see Khatib in view of Treleaven and in further view of Bausewein et al as described above). Second, the specific results applicant alleges are unexpected are also known to the prior art (see Scholz as described above). Therefore the examiner does not believe the fact pattern of *Merchant* applies to the fact pattern of the present application.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Telephone/Fax***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phil Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sells/  
Primary Examiner, Art Unit 1791